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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/930,418
Filing Date: August 15, 2001
Appellant(s): BUSH, LAWRENCE P.

Troy J. Cole
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03/12/2008 appealing from the Office action mailed 09/07/2007.

(1) Real Party In Interest

A statement identifying a real party in interest is present in the Appeal Brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed, contrary to Appellant's assertion. The record indicates that after the Final Rejection mailed 03/23/2007, the next response by Appellant was a Request for Continued Examination filed 06/25/2007.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Appellant's admitted prior art (hereinafter APA) from background information provided in the specification.

6,615,190	Slater	9-2003
2003/0018550	Rotman, et al.	1-2003
5,717,595	Cherrington, et al.	2-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-4, 7-20, 26, 27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appellant's admitted prior art (hereinafter APA; see specification of current application) in view of Slater (US Pat# 6,615,190, hereinafter Slater), and further in view of Rotman et al (PG Pub# US 2003/0018550, hereinafter Rotman).

A. As per claims 1, 26, and 29 APA discloses a method for administering insurance claims and monitoring claim-related data in a database, comprising the steps of:

- (a) receiving a claim (APA: pg 2, lns 2-3, reads on "...insured is required to submit a claim...);
- (b) determining a monetary value of said claim (APA: pg 2, lns 6-13; pg 3, lns 2-6).

APA fails to disclose steps c, d, and e. However, these features are well known in the art as evidenced by the teachings of Slater. Slater discloses

- (c) issuing a card representing an account;

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- (d) funding with at least a portion of said monetary value (for both c and d, Slater: Fig 1, items 20-24; col 3, lns 26-30; col 7, lns 25-30; Fig 1; col 4, lns 16-18);
- (e) monitoring the activity of said account to obtain information regarding usage of said card (Slater: col 5, lns 1-11; Fig 2, item 125; col 5, lns 21-30; Fig 2, item 130).

It would have been obvious at the time of the invention to one of ordinary skill in the art to incorporate the teachings of Slater with those of APA with the motivation of avoiding both the expense and inconvenience associated with the issuance of checks to pay insurance claims (Slater: col 1, lns 10-30; col 7, lns 25-30).

Note: The motivation to combine the teachings of APA and Slater for claims following in this section is the same as provided for claims 1, 26, and 29 above.

The combined teachings of APA and Slater fail to explicitly disclose step 1(f), however this feature is well known in the art as evidenced by the teachings of Rotman who teaches

- (f) analyzing said information to determine trends in said usage of said card (Rotman: [0024]; [0080]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Rotman with the collective disclosure of APA and Slater with the motivation of using purchase data to demonstrate industry-wide trends (e.g. automotive related industries) in near real-time (Rotman: [0021] – [0023]).

Note: Claim 29 is amended only is step (f) which reads

(f) analyzing said information on a card by card basis to determine trends in said usage of said cards.

This claim is rejected for the same reasons as provided for step f above.

Note also: The motivation to combine the teachings of APA, Slater, and Rotman for claims following in this section is the same as provided for claims 1, 26, and 29 above.

B. As per claim 2, Rotman discloses the method according to claim 1, wherein said trends comprise purchase trends (Rotman: [0054]-[0056]).

C. As per claims 3 and 27 (h), Slater discloses the method according to claim 1, further comprising the step of:

(g) analyzing said information to determine the accuracy of said determining said

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monetary value (Slater: col 6, Ins 7-12, reads on cardholder may check the balance.).

D. As per claim 4, Slater discloses the method according to claim 1 wherein said card account is

a debit card account (Slater: col 2, Ins 19-26; col 3, Ins 26-35. The Examiner considers a card issued to an individual, associated with an account that is funded by a known amount, which limits the amount of purchases that can be made with the card by limiting the purchases to debits of the account as opposed to an extension of credit, to be a form of debit card.).

E. As per claim 7, APA discloses the method according to claim 1, wherein said claim relates to

an automobile accident (APA: pg 2, Ins 1-3; pg 3, Ins 1-5).

F. As per claims 8 and 9, Slater discloses the method according to claim 1, wherein said claim relates to

(claim 8) medical treatment.

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and

(claim 9) death benefits (pertains to both the recitations of claims 8 and 9, Slater: col 7, lns 15-25, note that social security benefits claims include both medical treatment and death benefits.).

G. As per claim 10, APA discloses the method according to claim 1, wherein said claim relates to

property damage (APA: pg 2, lns 1-3; pg 3, lns 1-5. The Examiner considers an automobile accident to be a form of property damage).

H. As per claim 11, APA discloses the method according to claim 1, wherein said claim relates to

property loss (APA: pg 2, lns 1-3; pg 3, lns 1-5. The Examiner considers an automobile accident to be a form of property loss).

I. As per claim 12, APA discloses the method according to claim 1, wherein said claim relates to

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theft (Slater: col 7, Ins 25-30, note that theft insurance is a common type of insurance).

J. As per claims 13-16, Slater discloses the method according to claim 1, wherein the information obtained in step (e) includes

(claim 13) a time of usage of said card.

(claim 14) a monetary amount related to said usage of said card.

(claim 15) a place of usage of said card.

(claim 16) a time, place, and amount

of each occurrence of usage of said card (pertains to claims 13-16, Slater: col 2, Ins 42-49; col 5, Ins 3-11, note the disclosed maintenance of records for all account transactions, and the generation of a report listing the transactions. The Examiner considers such listings to include the time, place, and amount of the transactions including purchases).

K. As per claim 17, Slater discloses the method according to claim 1, further comprising the step of:

(g) closing said account after a predetermined amount of time (Slater: col 4, Ins 37-39; Fig 1, item 36).

L. As per claim 18, Slater discloses the method of claim 17, further comprising the step of:

before step (g), disbursing any balance remaining in said account (Slater: col 4, 64-66, note that the sponsor can remove and an employee can withdraw funds. The Examiner considers reducing funds from the account to zero prior to closing the account to be a form of disbursing remaining funds. See also col 5, ln 65 to col 6, ln 15, noting that the cardholder can transfer remaining balances to another account prior to account closure.).

M. As per claim 19, Slater discloses the method of claim 1 wherein said card account is managed by a

third party claim service provider (Slater: col 3, Ins 48-50, reads on "...credit network...").

N. As per claim 20, Slater discloses the method of claim 1 wherein said card account is managed by an

insurance company (Slater: col 2, lns 22-25; note the disclosure that a financial institution can be an issuer, that the Examiner considers an insurance company to be a type of financial institution. Note also that an insurance company can also be a sponsor, col 25-27, and further note that the sponsor is responsible for determining whether or not funds should be added to the account, which the Examiner considers to be a form of management.).

O. As per claims 27(f), and 27(g), Rotman teaches

(claims 27(f)) analyzing the collated data; and

(claims 27(g)) identifying statistically significant trends in the
purchase information (Rotman: [0024]).

4. Claims 6 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over APA, Slater, and Rotman as applied to claim 1 above, and further in view of Cherrington et al (US Pat# 5,717,595, hereinafter Cherrington).

A. As per claims 6, Slater teaches the method according to claim 1

wherein said usage of said card reflects the payment of an insurance claim
(Slater: col 7, lns 25-31).

The combined teachings of APA, Slater, and Rotman fail to disclose the remaining features of the claim, however, these features are well known in the art as evidenced by the teachings of Cherrington who teaches the method according to claim 1 wherein the insurance claim refers specifically to a vehicle repair

and further comprising the step of:

(g) comparing said determined monetary value of said claim to said actual repair cost of said vehicle (Cherrington: Fig 10, item 1012, col 20, lns 47-67).

It would have been obvious at the time of the invention to modify the combined teachings of APA, Slater, and Rotman to verify that the actual invoice cost of a vehicle repair does not exceed the estimated cost by more than the legally allowed amount (Cherrington: col 2, lns 51-57). The same motivation applies to claim 28 below.

B. As per claim 28, the combined teachings of APA, Slater, and Rotman fail to disclose the features of the claim, however, they are well known in the art as evidenced

by the teachings of Cherrington who teaches the method according to claim 27, further comprising the step of:

- (i) modifying said determining said monetary value in response to said evaluated accuracy of said monetary value determination (Cherrington: Fig 10, item 1008-1010, col 20, lns 47-67).

(10) Response to Argument

Appellant's arguments with respect to claims 1, 26, and 29 (step f in each claim) have been considered but are not considered persuasive. Appellant argues essentially that the combined teachings of APA, Slater, and Rotman do not teach the feature, as illustrated in exemplary claim 1, step f, of

analyzing said information to determine trends in said usage of said cards, in particular because the Rotman reference is directed towards analysis of aggregated cardholder data and not individual data, and thus "teaches away" from the claim.

In response, the Examiner first notes that the Slater reference explicitly teaches individual accounts with cards to be funded and used for the purpose of administering and paying insurance claims (Slater col 2, lns 10-18; col 7, lns 25-30). Slater further teaches a plurality of computer modules for administering data associated with the

account (Slater: cols 4-5). Note in particular that the “transaction database module” maintains cardholder transaction data which may be made available to the card “sponsor” for analysis (Slater: col 5, lns 1-10). Note further the existence of “Input/Output” modules for both sponsors and issuers, where both have access to and may request information pertaining to the transaction activity of individual accounts (Slater: col 5, lns 21-46). Thus it is firmly established by the Slater reference that individual cardholder information is of interest and could be used by a sponsor or issuer for analysis. What remains are the specific details of analysis, which are provided by Rotman.

Rotman discloses that cardholder individual demographic information is acquired and used to offer extra products and services to individual cardholders (Rotman: [0011] and [0013]), though cardholders are offered the option of removing their names from mailing lists if they object to this practice. Rotman notes that individual purchase data from individuals is more controversial to use than individual demographic data (Roman: [0014]), however, Rotman does not state or imply that individual information could not be used, or would not be useful, only that consumers might object, and that issuers frequently adopt policies against the practice to allay such consumer concerns. Because there is no teaching explicitly against the utilization of individual cardholder information (and in fact there is teaching that it is an industry practice in some quarters), it has not been reasonably established that the Rotman reference teaches away from the use of individual cardholder data for trends analysis as is asserted by Appellant.

The Examiner thus maintains that the analytical processes taught by Rotman as cited in the grounds of rejection above could readily be adapted by one of ordinary skill in the art to individual cardholder data as taught by Slater should a company make the policy choice to do so. One straightforward example is provided in Rotman: [0054] which teaches accumulating a cardholder's transaction data for a predetermined period of time, then aggregating this individual's data according to the companies from which the cardholder makes purchases. This individual cardholder data could be used by the sponsors and/or issuers of Slater as a type of individual cardholder trend analysis, or it could be further aggregated with other cardholder data to produce broader population trends.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Martin A. Gottschalk/

Examiner, Art Unit 3696

Conferees:

Vincent Millin /VM/

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Appeals Practice Specialist

Ella Colbert /E. C./

Primary Examiner

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